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In re Application of : DECISION ON PETITION UNDER
Endo, Tamio, et al. : 37 CFR 1.47(a)
U.S. Application No.: 10/510,244 :
PCT No.: PCT/JP03/04750 :
International Filing Date: 15 April 2003 :
Priority Date: 16 April 2002 :
Attorney's Docket No.: 040473 :
For: RESIST FILM REMOVING :
APPARATUS ... AND METHOD OF :
REMOVING ORGANIC MATTER :
:

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(a)" filed 19 September 2005. Applicant has submitted \$130 as the petition fee, and included the authorization to charge Deposit Account No. 01-2340 for additional fees. Because the fee for a petition under 37 CFR 1.47(a) is \$200, Deposit Account No. 01-2340 will be charged the additional \$70 required to complete the petition fee.

BACKGROUND

On 15 April 2003, applicants filed international application PCT/JP03/04750 which claimed a priority date of 16 April 2002 and which designated the United States. On 23 October 2003, a copy of the international application was communicated to the United States Patent And Trademark Office (USPTO) by the International Bureau (IB). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 16 October 2004.

On 15 October 2004, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English.

On 17 June 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497 was required.

On 19 September 2005, applicants filed a response to the Notification Of Missing Requirements (with required extension fee) which included a declaration executed by six of the seven inventors, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks

acceptance of the application without the signature of inventor Atsushi SATO, whom applicants assert cannot be located after diligent effort.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the nonsigning inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Here, applicants have provided the required petition fee, and the petition expressly states the last known address of the nonsigning inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Applicants have filed a declaration executed by six of the seven inventors and containing an unsigned signature block for the nonsigning inventor Atsushi SATO. Accordingly, if the declaration was otherwise acceptable, the declaration could be accepted as having been signed by all the inventors on their own behalf and on behalf of the nonsigning inventor. However, the Japanese/English language declaration used by applicants is not a form provided by the USPTO, and applicants have not provided a certification of translation, as required (see 37 CFR 1.69(b)). Until a certification of the translation is provided, the declaration cannot be accepted. Accordingly, on the present record, item (3) is not satisfied.

Regarding item (4), the petition asserts that the assignee cannot be located after diligent effort. With respect to such circumstances, MPEP section 409.03(d) states the following:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or

reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

In the present petition, applicant has not provided the required showing that the nonsigning inventor cannot be located after diligent effort. Specifically, it is not clear that the person providing the "Declaration In Support Of Petition Under 37 CFR 1.47(a)" (Takayoshi KOKUBIN) is the person who took the actions referred to therein; it is therefore unclear whether Takayoshi KOKUBIN has first hand knowledge of these actions, as required by the MPEP. In addition, applicant has not provided any documentary evidence of the efforts made to locate the inventor (for example, the petition refers to a 27 September 2004 mailing to the inventor that was returned, and it states that a copy of this mailing is attached; however, no such materials are present in the application file). In addition, it does not appear that applicants have performed an internet search as part of the effort to locate the nonsigning inventor.

Before item (4) can be considered satisfied, applicants must provide the required firsthand evidence (with documentary support) demonstrating that a diligent effort has been made to locate the nonsigning inventor. A diligent effort to locate the inventor should include an internet search, and the results of such a search should be included in any subsequent submission herein.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy items (3) and (4) of a grantable petition, as discussed above. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application.
Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

RRR

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